

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte WALTER HAECKER and HANS-DIETER DAHMEN

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Appeal No. 2001-2671  
Application No. 09/258,155

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HEARD: January 22, 2002

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Before COHEN, STAAB, and NASE, Administrative Patent Judges.  
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1, 3 to 5 and 7. Claims 2, 6 and 8 were canceled in the response filed August 21, 2000 (Paper No. 6). The appeal with respect to claims 9 to 11 was withdrawn in the reply brief (Paper No. 12, filed June 1, 2001).<sup>1</sup>

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<sup>1</sup> Claim 8 was directed to be canceled in the response filed August 21, 2000. However, since the appellants also amended claim 8 in the response filed August 21, 2000, claim 8 was not canceled. In view of the appellants' statement in the brief (p. 2) that claim 8 should have been canceled, we view claim 8 as being canceled. We suggest that a formal amendment canceling claims 8 to 11 be submitted as soon as possible.

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We REVERSE.

BACKGROUND

The appellants' invention relates to a process for controlling a roof of a vehicle, which is to be opened in a power-operated manner (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Baratelli 1971	3,577,164	May 4,
Weissrich et al. (Weissrich)	5,749,617	May 12, 1998

Claims 1, 3 to 5 and 7 stand rejected under 35 U.S.C. § 112, first paragraph.

Claims 1, 3 to 5 and 7 stand rejected under 35 U.S.C. § 101.

Claims 1 and 3 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Weissrich.

Claim 5 stands rejected under 35 U.S.C. § 103 as being unpatentable over Weissrich.

Claims 4 and 7 stand rejected under 35 U.S.C. § 103 as being unpatentable over Weissrich in view of Baratelli.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the final rejection (Paper No. 7, mailed September 5, 2000) and the answer (Paper No. 11, mailed April 2, 2001) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 10, filed February 5, 2001) for the appellants' arguments thereagainst.

#### OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the

examiner. As a consequence of our review, we make the determinations which follow.

**The rejection under 35 U.S.C. § 112, first paragraph**

We will not sustain the rejection of claims 1, 3 to 5 and 7 under 35 U.S.C. § 112, first paragraph.

The description requirement exists in the first paragraph of 35 U.S.C. § 112 independent of the enablement (how to make and how to use) requirement.<sup>2</sup> The examiner has asserted (final rejection, pp. 2-3) that the claims under appeal fail to meet both the description requirement and the enablement requirement.

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<sup>2</sup> It is well settled that the description and enablement requirements are separate and distinct from one another and have different tests. See In re Wilder, 736 F.2d 1516, 1520, 222 USPQ 369, 372 (Fed. Cir. 1984), cert. denied, 469 U.S. 1209 (1985); In re Barker, 559 F.2d 588, 591, 194 USPQ 470, 472 (CCPA 1977); and In re Moore, 439 F.2d 1232, 1235-36, 169 USPQ 236, 239 (CCPA 1971).

As to the rejection based on the description requirement,<sup>3</sup> the examiner has not set forth any explanation whatsoever for this rejection. In that regard, the examiner has not set forth the claimed subject matter which the examiner believed was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the appellants, at the time the application was filed, had possession of the claimed invention. Accordingly, we cannot sustain the rejection of claims 1, 3 to 5 and 7 under 35 U.S.C. § 112, first paragraph, based upon the description requirement.

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<sup>3</sup> The test for determining compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter, rather than the presence or absence of literal support in the specification for the claim language. See Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1116-17 (Fed. Cir. 1991) and In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983).

As to the rejection based on the enablement requirement,<sup>4</sup> it is our view that the examiner has not met the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention.<sup>5</sup> A disclosure which contains a teaching of the manner and process of making and using an invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented must be taken as being in compliance with the enablement requirement of 35 U.S.C. § 112, first paragraph, unless there is a reason to doubt the objective truth of the statements contained therein which must be relied on for enabling support.<sup>6</sup>

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<sup>4</sup> The test for enablement is whether one skilled in the art could make and use the claimed invention from the disclosure coupled with information known in the art without undue experimentation. See United States v. Teletronics, Inc., 857 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988), cert. denied, 109 S.Ct. 1954 (1989); In re Stephens, 529 F.2d 1343, 1345, 188 USPQ 659, 661 (CCPA 1976).

<sup>5</sup> See In re Wright, 999 F.2d 1557, 1561-62, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993) (examiner must provide a reasonable explanation as to why the scope of protection provided by a claim is not adequately enabled by the disclosure).

<sup>6</sup> As stated by the court in In re Marzocchi, 439 F.2d 220, 223, 224, 169 USPQ 367, 370 (CCPA 1971)

(continued...)

In applying the above-noted test for enablement, factors which must be considered in determining whether a disclosure would require undue experimentation include (1) the quantity of experimentation necessary, (2) the amount of direction or guidance presented, (3) the presence or absence of working examples, (4) the nature of the invention, (5) the state of the prior art, (6) the relative skill of those in the art, (7) the predictability or unpredictability of the art, and (8) the breadth of the claims. See In re Wands, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988) citing Ex parte Forman, 230 USPQ 546, 547 (Bd. Pat. App. & Int. 1986).

Our review of the record reveals that the examiner has not applied the above-noted factors to determine that undue experimentation would be required to practice the invention or

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<sup>6</sup>(...continued)

it is incumbent upon the Patent Office, whenever a rejection on this basis is made, to explain why it doubts the truth or accuracy of any statement in a supporting disclosure and to back up assertions of its own with acceptable evidence or reasoning which is inconsistent with the contested statement. Otherwise, there would be no need for the applicant to go to the trouble and expense of supporting his presumptively accurate disclosure.



provided an explanation that clearly supports such a determination. Since the examiner has not weighed the factors, the examiner's conclusion of nonenablement cannot be sustained.

Furthermore, it is our view that it would not require undue experimentation to practice the invention as set forth in claim 1 under appeal. In that regard, from a review of the prior art cited in the record of this application, we conclude that a person skilled in the art would know how to make and use (1) a drive mechanism for controlling movement of a vehicle roof that is to be moved by power in opening and closing operating directions, (2) a sensor for determining whether the roof is fully open, and (3) a circuit whereby if the roof is fully open, a closing operation of the roof is triggered, and if the roof is not fully open, an opening operation of the roof is triggered. Thus, we conclude that one skilled in the art could make and use the claimed invention from the disclosure without undue experimentation.

For the reasons set forth above, the decision of the examiner to reject claims 1, 3 to 5 and 7 under 35 U.S.C. § 112, first paragraph, is reversed.

**The rejection under 35 U.S.C. § 101**

We will not sustain the rejection of claims 1, 3 to 5 and 7 under 35 U.S.C. § 101.

The examiner has asserted (final rejection, pp. 3-4) that the disclosed invention is inoperative and therefor lacks utility. We do not agree for the reasons set forth above in our discussion of the rejection under 35 U.S.C. § 112, first paragraph, based on the enablement requirement. Suffice it to say, it is our view that the claimed invention is operative and has utility. Accordingly, the decision of the examiner to reject claims 1, 3 to 5 and 7 under 35 U.S.C. § 101 is reversed.

**The rejection under 35 U.S.C. § 102(e)**

We will not sustain the rejection of claims 1 and 3 under 35 U.S.C. § 102(e).

To support a rejection of a claim under 35 U.S.C. § 102(e), it must be shown that each element of the claim is found, either expressly described or under principles of inherency, in a single prior art reference. See Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984).

Claim 1 reads as follows:

Process for controlling movement of a vehicle roof that is to be moved by power in opening and closing operating directions, comprising the steps of moving a single triggering element, for both the opening and closing operating directions, and selecting the opening or closing directions with the single triggering element as a function of a position of the roof, the operating directions being determined by sensing whether the roof is fully open, whereby; if the roof is fully open, a closing operation of the roof is triggered, and if the roof is not fully open, an opening operation of the roof is triggered.

Weissrich discloses a motor vehicle roof which can be opened by a motor through various interim stages by operation of a rotary switch about which graphic symbols are arranged which indicate the respective opening stages. The control is suited for triggering complex, openable motor vehicle roofs

with several roof components which can be activated partially independently of one another and which can be activated by separate motors; the switch, as it turns in different peripheral areas, triggering individual or multiple motors in succession or at the same time for starting predetermined opening stages.

Claim 1 is not anticipated by Weissrich. In that regard, Weissrich does not disclose the step of moving a single triggering element, for both the opening and closing operating directions of a vehicle roof. Weissrich uses a rotary switch 21 with a single rotary knob and as the rotary knob is rotated it activates different triggering elements to open and close the vehicle roof, not a single triggering element, for both the opening and closing operating directions of a vehicle roof. Furthermore, Weissrich does not disclose the step of sensing whether the roof is fully open. In our view, this step is not readable on a person looking at the roof and noticing that the roof is fully open. Instead, this step requires a sensing device determining whether the roof is fully open. Additionally, Weissrich does not disclose the

claimed interaction between the claimed single triggering element and the sensing of whether the roof is fully open (i.e., if the roof is sensed as fully open, a closing operation of the roof is triggered by operation of the single triggering element, and if the roof is sensed as not fully open, an opening operation of the roof is triggered by operation of the single triggering element).

For the reasons set forth above claim 1 is not anticipated by Weissrich. Accordingly, the decision of the examiner to reject claim 1 and claim 3 dependent thereon under 35 U.S.C.

§ 102(e) is reversed.

**The rejections under 35 U.S.C. § 103**

We will not sustain either the rejection of claim 5 under 35 U.S.C. § 103 as being unpatentable over Weissrich or the rejection of claims 4 and 7 under 35 U.S.C. § 103 as being unpatentable over Weissrich in view of Baratelli since the limitations of parent claim 1 not taught by Weissrich (see our discussion above) have not been asserted by the examiner to

have been obvious at the time the invention was made to a person of ordinary skill in the art.

#### CONCLUSION

To summarize, the decision of the examiner to reject claims 1, 3 to 5 and 7 under 35 U.S.C. § 112, first paragraph, is reversed; the decision of the examiner to reject claims 1, 3 to 5 and 7 under 35 U.S.C. § 101 is reversed; the decision of the examiner to reject claims 1 and 3 under 35 U.S.C. §

102(e) is reversed; and the decision of the examiner to reject  
claims 4, 5 and 7 under 35 U.S.C. § 103 is reversed.

REVERSED

IRWIN CHARLES COHEN	)	
Administrative Patent Judge	)	
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	)	
	)	
	)	BOARD OF PATENT
LAWRENCE J. STAAB	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
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	)	
JEFFREY V. NASE	)	
Administrative Patent Judge	)	

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